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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,452	03/08/2001	Archibald I.J. Brain	108195.128	8539

23483 7590 07/02/2002

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EXAMINER

LEWIS, AARON J

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/803,452**

Applicant(s)  
**ARCHIBALD I.J. BRAIN**

Examiner  
**AARON J. LEWIS**

Art Unit  
**3761**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06/24/2002 (RCE)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 and 36-38 is/are allowed.
- 6) ☒ Claim(s) 30-34 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 25 and 27 are objected to because of the following informalities: Claims 25 and 27 are new claims with respect to patent '745. As new claims they must be presented with underlining throughout the claim. (See MPEP 1453 beginning after the subheading "Examples of Proper Amendments" and most specifically see text under subheadings "Presentation of New Claims" and "Amendment of New Claims"). Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37CFR 1.121(b). Appropriate correction is required.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/24/2002 has been entered.

### ***Reissue Applications***

3. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,878,745 , which is material to patentability of the claims under consideration in this reissue

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application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Brain ('879).

As to claim 30, Brain discloses a device, including: an airway tube (11) for supplying air to a patient; an evacuation tube (51) for communication with a laryngeal inlet of the patient, the mask including a back cushion (33) for contacting a pharyngeal wall of the patient and biasing (i.e. due to its inflation) at least part of the mask away from the pharyngeal wall, the back cushion defining a periphery (i.e. the periphery corresponding to the points of attachment to ring #18; col.3, lines 33-34 and col.4, lines 38-40), a first portion of the back cushion being sealed to a first portion of the evacuation tube (col.4, lines 40-41), the first portion of the back cushion being spaced apart from the periphery (i.e. the portion of the back cushion which is sealed around the evacuation tube as illustrated in figs.3-5 is spaced apart from the portion which is sealed to ring 18).

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As to claim 31, a segment of the evacuation tube (51) of Brain is sealed to the back cushion (col.4, lines 40-41).

As to claims 32 and 34, Brain (fig.5) illustrates a first portion of the evacuation tube (51) being sealed to the back cushion and a second portion opposite the first portion being sealed to the mask (i.e. to the right of reference numeral 51).

As to claim 33, mask of Brain (figs.2 and 2A) includes a generally elliptical ring (18).

***Allowable Subject Matter***

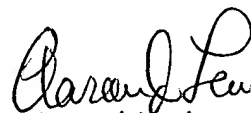
7. Claims 1-29,36-38 are allowed.
8. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 30-34 have been considered but are moot in view of the new ground(s) of rejection.
10. Any inquiry concerning this communication should be directed to Aaron J. Lewis at telephone number (703) 308-0716.

Aaron J. Lewis

June 30, 2002

  
Aaron J. Lewis  
Primary Examiner